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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,498	07/28/2006	Winfried Bunsmann	016382-9012	8995

7590 02/05/2007  
Michael Best & Friedrich  
Suite 3300  
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EXAMINER
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CHENEVERT, PAUL A

ART UNIT	PAPER NUMBER
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3612

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/564,498

Applicant(s)

BUNSMANN ET AL.

Examiner

Paul A. Chenevert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 is/are allowed.
- 6) ☒ Claim(s) 9, 16-18 and 25 is/are rejected.
- 7) ☒ Claim(s) 10-15, 19-24, 27 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2006 07 28.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

3. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). It appears that only the specification, abstract, and claims were submitted in this application on 12JAN06. The only drawings found were from the earlier foreign priority document.

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4. The drawings are objected to because of the following minor informalities:
  - a. Reference number 24 designating the forward guide element in Figure 7 located between reference numbers 4 & 10 should be changed to 20 (see paragraph 0027, line 2).
  - b. Reference number 34 in Figures 10 & 11 should be changed to 28.
5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### *Specification*

6. The disclosure is objected to because of the following informalities:
  - a. Paragraph 0027, line 1, “roof part 12” should be changed to “roof part 10”.

b. Paragraph 0036, line 4, it is unclear how the latch 30 can be employed to secure the lowered roof art 10 as is disclosed in the last sentence "In the alternative, the latching can also take place with the latch 30". As this feature is not claimed, this issue is minor. Appropriate correction is required.

### *Claim Objections*

7. Claims 9-25, 27 & 28 are objected to because of the following informalities:
- a. Claim 9, line 3, "traverse" should be changed to "transverse" and "traversely" should be changed to "transversely".
  - b. Claim 9, line 7, "traverse" should be changed to "transverse".
  - c. Claim 9, line 13, "its" should be changed to "the roof part's".
  - d. Claim 10, line 2, "defined by" should be changed to "located on".
  - e. Claim 11, line 2, "defined by" should be changed to "located on".
  - f. Claim 17, line 3, "traverse" should be changed to "transverse" and "traversely" should be changed to "transversely".
  - g. Claim 17, line 7, "traverse" should be changed to "transverse".
  - h. Claim 17, lines 12-15, "the roof part" (four occurrences) should be changed to either "the first roof part" or "the second roof part".
  - i. Claim 17, line 17, "its" should be changed to "the second roof part's".
  - j. Claim 19, line 2, "defined by" should be changed to "located on".
  - k. Claim 20, line 2, "defined by" should be changed to "located on".

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l. Claim 25, line 1, “the roof part” (four occurrences) should be changed to either “the first roof part” or “the second roof part”.

m. Claim 27, line 2, “defined by” should be changed to “located on”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 9 & 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ney et al. (US 5,056,857 A; 15OCT91).

Ney et al. disclose a targa roof system comprising: a cross member (cross pillar); a transverse cross beam (B-pillar 35); a first roof part (roof panel 50); a second roof part (cover panel 52); two guide rails (74 & 76); a guide device (bracket 90) including a forward guide element (sliding member 96) and a rear guide element (block 102); and wherein the roof part is pivotable via the guide elements with respect to the roof about the roof part's rear area from a closed position into an upwardly tilted position and then is downwardly lowerable into a stowed position by being guided along the guide rails via the forward guide element and the rear guide element without pivoting relative to the guide rails for at least a portion of the downward movement.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 16 & 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ney et al. in view of Ellerbeck (US 1,784,279 A; 09DEC30).

Ney et al. disclose a targa roof system with a lowered roof panel behind the vehicle seat.

However, Ney et al. do not expressly disclose that the roof panel has a forward end transparent.

Ellerbeck discloses a convertible roof having a roof panel stored behind the vehicle seat and having a transparent forward end (22).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the targa roof system of Ney et al., to employ a transparent forward end of the roof panel, as taught by Ellerbeck.

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The suggestion/motivation for doing so would have been to allow visual inspection of the area directly behind the stored roof panel, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the targa roof system of Ney et al. by combining a transparent forward end with the roof panel to obtain the invention as specified in claims 16 & 25, as taught by the prior references' motivation, and not hindsight from the applicants disclosure.

13. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ney et al. in view of Furst et al. (US 5,558,388 A; 24SEP96).

Ney et al. disclose a targa roof system with a lowered roof panel.

However, Ney et al. do not expressly disclose that the system includes foldable longitudinal crossbeams.

Furst et al. disclose a convertible roof having foldable longitudinal crossbeams (6a).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the targa roof system of Ney et al., to employ foldable crossbeams, as taught by Furst et al.

The suggestion/motivation for doing so would have been to allow for a stronger roof support in the raised position, as is desired in this vehicle invention.

Therefore, it would have been a desirable and thus a prima facie obvious modification of the targa roof system of Ney et al. by combining foldable crossbeams with the roof panel to obtain the invention as specified in claim 18, as taught by the prior references' motivation, and not hindsight from the applicants disclosure.



***Allowable Subject Matter***

14. Claim 26 is allowed.
15. Claims 27 & 28 would be allowable if rewritten to overcome the objection set forth in this Office action.
16. Claims 10-15 & 19-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
17. The following is an examiner's statement of reasons for allowance: the prior art does not show or make obvious Applicant's first and second guide elements rigidly fixed to the rear of a roof panel which are tilted to be received in a single guide rail. In regards to claims 10, 15, 19 & 24, the prior art does not show or make obvious Applicant's tiltable guide rails.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Chenevert whose telephone number is 571-272-6657. The examiner can normally be reached on Mon-Fri (8:30-5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn D. Dayoan can be reached on 571-272-6659. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Paul A. Chenevert  
Examiner  
Art Unit 3612

PAC  
29JAN07

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